



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,268	07/23/2001	Thomas Eckel	Mo6438 LeA 34,675	4109

157 7590 09/17/2003

BAYER POLYMERS LLC  
100 BAYER ROAD  
PITTSBURGH, PA 15205

EXAMINER
----------

YOON, TAE H

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/911,268	ECKEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tae H Yoon	1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1714

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 15-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,441,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because the bisphenol A as X in claims 1 and 3 meets the instant phosphorous compound.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6, 8-10, 12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Improper Markush language is recited in claims 1, 8-10, 12 and 17, and an insertion of "the group consisting of" after "selected from" is needed. In claim 6, a

Art Unit: 1714

substitution of "comprising" in line 7 with "consisting" is needed. The recited "derivatives" in claim 8 is indefinite absent particular substituents or functional groups. The recited EP(D)M in claim 8 is indefinite and a full chemical spelling is needed. The recited "may be selected, are selected" in claim 17 is confusing and deletion of said "may be selected," is suggested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 99/07782.

Art Unit: 1714

Note that US Pat. 6,569,930 is an English equivalent to WO 99/07782 (based on DE 197 34 661), and the examiner points out said US patent.

US (WO) teaches a flame resistant composition comprising aromatic polycarbonate, graft polymer, a phosphorous compound, fluorinated polyolefin and inorganic compound in abstract and at col. 2, line 27 to col. 3, line 12. The instant phosphorus compound is taught at col. 8, line 30. 34-35, and col. 12, Component D.1 which is free of other homolog or derivative. The instant graft polymer is taught at cols. 5-6, and the graft base of a preferred graft polymer in lines 21-30 has the instant Tg as evidenced by claim 1. Various additives and molded articles are taught at col. 10, lines 36-47.

Thus, the instant invention lacks novelty.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckel et al (US 6,569,930). Eckel et al are discussed above, and thus the instant invention lacks novelty.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckel et al (US 6,441,068).

Eckel et al teach the instant composition throughout the patent as in the US US 6,569,930. The phosphorous compound D of claim 1 with the bisphenol A as X of claim 3 meets the instant phosphorous compound. Thus, the instant invention lacks novelty.

Art Unit: 1714

Claims 1-17 are rejected under 35 U.S.C. 103(a) as obvious over Eckel et al (US 6,569,930) in view of Castelnuovo et al (US 3,919,353).

Eckel et al teach the graft polymer based on US Pat. 3,919,353 at the bottom of page 10, and said US Pat. 3,919,353 teaches Tg of less than 10°C in table of col. 3 and at col. 6, line 30, respectively. Note that homopolymers of both methacrylate and styrene monomer components of the MBS have Tg of more than 100°C, and thus the graft base, polybutadiene, obviously meets the instant Tg of less than 10°C.

It would have been obvious to one skilled in the art at the time of invention to utilize a graft polymer with a graft base having Tg of less than 10°C in Eckel et al with teaching of Castelnuovo et al since Eckel et al teach Castelnuovo et al.

Claims 1-17 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 198 53 105.

The translated DE teaches the instant composition at page 2, line 26 to page 4, line 7. The graft polymers are taught at page 10-13, and the ABS graft polymer at page 12, line 29 inherently meets the instant Tg for the graft base, (poly)butadiene. The instant phosphorus compound is taught at page 17, line 20. Other additives and molded articles are taught at pages 21-23.

Thus, the instant invention lacks novelty.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 771 851.

Art Unit: 1714

EP teaches the instant composition in abstract and claims. The instant phosphorus compound is taught at page 6, lines 35-40, the preferred bisphenol A as R<sup>9</sup>. ABS graft polymer is seen in table 1. Thus, the instant invention lacks novelty.

Claims 1-5 and 10-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Norris et al (US 4,246,169).

Norris et al teach the instant composition at col. 18, lines 61-62 and col. 23, structure (B) and col. 24, table. Thus, the instant invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/September 15, 2003